

II. Rejections Under 35 U.S.C. §101

Claims 1-4 were rejected as claiming the same invention as that of claims 1-24 of U.S. Patent No. 5,432,054 ("the '054 patent"). This rejection is without basis.

The '054 patent claims a method for obtaining fetal nucleated red blood cells from maternal blood by, roughly speaking, *centrifuging* a blood sample to obtain red blood cells, *transferring* the red blood cells to centrifuge tube containing a special *density gradient medium* comprising a meltable gel, *hemolysis* of maternal cells, *melting* the gel of the density gradient medium, and *centrifuging* the cells through the density gradient medium.

In contrast, the present invention is wholly unrelated to the cited patent and, for example, does not involve centrifugation or density gradient medium. This rejection should be withdrawn.

III. Rejections Under 35 U.S.C. §103(a)

Claims 1-20 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Heiden et al. (1991) in view of Vaigot et al. (1985) further in view of Schindler (1986).

A. The cited art

Heiden and Vaigot

Heiden and Vaigot are cited for teaching flow cytometry to isolate cells in a population. The present invention does not use flow cytometry. Nothing in Heiden et al. or Vaigot et al. suggested the present method which, *inter alia*, does not involve flow cytometry.

Schindler 1986

Two references "Schindler 1986" are of record and the Action includes no indication of which reference is intended. Applicants presume the reference to be Schindler 1986 (U.S. Pat. No. 4,629,687) because the abstract of this patent refers to a photomultiplier as referred to by the Examiner. The '687 patent described a method for selection of viable cells by using a radiant energy source (e.g., a laser beam) to kill unwanted cells. See abstract and claims. Nothing in the '687 patent suggested the present invention comprising, *inter alia*,

illuminating a solidifiable material over a cell of interest to form a solid plug (to which the cell of interest adheres and/or which protects the DNA of the cell from a DNA-inactivating material). See claims 1-18 of the instant application. Similarly, nothing suggested the method of claims 19-20.

B. The traverse

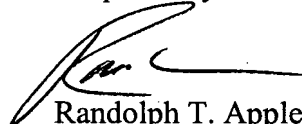
The Examiner has failed to establish a *prima facie* case of obviousness. A proper *prima facie* case of obviousness requires that three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. No such suggestion can be found in the references cited by the Examiner, and the Examiner has not provided any argument or basis on which the references might be combined. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Although it is not clear how the Examiner contemplates combining the presently cited references, it is clear that elements of the present claims (e.g., a solidifiable material) are neither taught nor suggested in the cited references. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2142.

Further, the initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (BPAI 1985). See MPEP §2142. The Examiner has failed to suggest any basis for combining or modifying any of the cited references. When the motivation to combine the teachings of the references is not immediately apparent, it is the encumbent on the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (BPAI 1986).

No *prima facie* case of obviousness has been made or can be made. Thus, Applicants respectfully request that this rejection be withdrawn.

It is believed that the above amendments and remarks place the pending claims in condition of allowance. Issuance of a Notice of Allowance is respectfully requested. If the Examiner believes a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (650) 326-2400, Ext. 5270.

Respectfully submitted,



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